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In re Application of	:	DECISION ON
CAMPBELL et al	:	
PCT No.: PCT/US2004/026981	:	
Application No: 10/569,021	:	
Int. Filing Date: 19 August 2004	:	PETITION UNDER
Priority Date: 20 August 2003	:	
Attorney's Docket No.: 2G02.1-082 1	:	
For: BLOOD SAMPLING DEVICE	:	37 CFR 1.47(a)

This is in response to the "PETITION TO ACCEPT ... OR CANNOT BE REACHED (37 CFR 1.47(a))" filed on 08 December 2006. The petition fee is now \$200.00 for a petition under 37 CFR 1.47(a) so \$70 has been charged to petitioner's deposit account 50-1513 as stipulated in the petition letter filed on 08 December 2006.

BACKGROUND

On 19 August 2004, petitioner filed international application PCT/US2004/026981, which claimed priority to an earlier application filed 20 August 2003. The thirty-month (30) time period for paying the basic national fee in the United States of America expired at midnight on 20 February 2006.

On 17 February 2006, petitioner filed in the United States Patent & Trademark Office a transmittal letter for entry into the national stage in the U.S. under 35 U.S.C. 371, which was accompanied by, inter alia, the U.S. basic national fee, and an executed declaration but without the signature of one of the joint inventors, Mitchell A. Solis, accompanied the above papers.

On 07 September 2006, the United States Designated/Elected Office (DO/EO/US) mailed a "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)" (Form PCT/DO/EO/905) which informed applicant, inter alia, that an "Oath or Declaration of the inventors, in compliance with 37 CFR 1.497(a), and (b), identifying the application by the International application number and international filing date" and to avoid abandonment. The notice indicated that the items must be submitted within two months from date of mailing or by 32 months from the priority date of the application, in order to avoid abandonment of the national stage application.

On 08 December 2006, petitioner filed the present petition, a declaration in support of filing on behalf of omitted inventor Mitchell A. Solis.

DISCUSSION

PETITION UNDER 37 CFR 1.47(a):

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(g), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

Furthermore, section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.) **Proof of Unavailability or Refusal**, the relevant sections states, in part:

REFUSAL TO JOIN:

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Proof that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

When it is concluded by the **37 CFR 1.47** applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

Petitioner has satisfied requirements (1) and (3) - (4) of 37 CFR 1.47(a) but not requirement (2).

Regarding requirement (1), petitioner has now provided the complete petition fee of \$200.00 under 37 CFR 1.17(g).

Regarding requirement (2), in this case, it has been sufficiently demonstrated that a copy of the application papers were mailed to the non-signing inventor, Mitchell A. Solis but it is not clear if he received the papers. Although the FedEx Track states that it was delivered, it was left at the front door. Consequently, it is unclear if Mr. Solis received the papers because there is no signature of receipt by someone at the residence and petition also alleges not he could not be reached after diligent effort via phone calls.

Moreover, from the declaration, it appears that no further attempts were made to delivery the application papers so as to show that Mr. Solis actually received the delivery of the papers. Where the Office is being asked to accept the silence of the nonsigning inventor's as evidence of a refusal to sign, petitioner must provide some evidence that the application materials have been received by the nonsigning applicant. Absent further firsthand evidence that the application and request for signature were received by the nonsigning inventor, item (2) cannot be considered satisfied.

In addition, it is unclear if Mr. Solis still resides in that address. If not, then petitioner is under an obligation to try to find or reach Mr. Solis. Where there is an inability to find or reach a joint inventor "after diligent effort," petitioner may file a statement of facts that fully describes the exact facts which are relied on to establish that a diligent effort was made under **37 CFR 1.47**.

Regarding requirement 3, petitioner has provided a statement of the last known address of the missing inventor.

Regarding requirement 4, petitioner has provided an executed declaration signed by LeVAUGHN, KENNEDY, RUF, ROBBINS, HEATH, FLYNN, CAMPBELL, GRIFFIN, IRWIN, and PYNES on their behalf and on the behalf of the nonsigning joint inventor Mitchell A. SOLIS.

Consequently, the current record does not sufficiently establish Mr. Solis' refusal to join in the application because no evidentiary documents have been submitted in English to show that a *bona fide* attempt was made to deliver the complete application to him and that he received and signed for the papers.

CONCLUSION

The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration of the merits of the petition under 37 CFR 1.47(a) is desired, applicant must file a request for reconsideration within **TWO (2) MONTHS** from the mail date of this Decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." Extensions of time are available under 37 CFR 1.136(a). Failure to timely file the proper response will result in ABANDONMENT.

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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